

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
FORT WORTH DIVISION**

ROOTS IP, LLC,

Plaintiff,

V.

TEXAS ROOTS ENDODONTICS, PLLC,

Defendant.

Civil Action No. _____

JURY TRIAL DEMAND

**PLAINTIFF'S ORIGINAL COMPLAINT FOR
TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION**

Plaintiff Roots IP, LLC sets out its complaint against Defendant Texas Roots Endodontics, PLLC, and alleges as follows:

NATURE OF THE CASE

1. This is a civil action for trademark infringement and unfair competition under the Lanham Act, 15 U.S.C. §§ 1114(1)(a) and 1125(a) and common law arising from Defendant's trading on Plaintiff's goodwill through the use of Plaintiff's trademark.

THE PARTIES

2. Plaintiff Roots IP, LLC is a Texas limited liability company with its principal place of business at 5444 Westheimer Rd., Suite 1640, Houston, Texas 77056. Plaintiff is represented by the undersigned counsel.

3. Defendant Texas Roots Endodontics, PLLC is a Texas professional limited liability company with its principal place of business at 2417 Presidio Vista Dr., Suite 200, Fort Worth,

Texas 76177. Defendant may be served with process by serving its registered agent, Joshua Melton, at 2417 Presidio Vista Dr., Suite 200, Fort Worth, Texas 76177 or wherever else he may be found.

JURISDICTION AND VENUE

4. This Court has original subject matter jurisdiction over Plaintiff's claims as this action asserts violations under 15 U.S.C. §§ 1114 and 1125. Therefore, this Court has jurisdiction over those claims, and related unfair competition and state law claims, pursuant to 15 U.S.C. § 1121(a), 28 U.S.C. §§ 1331, 1338(b), and 1367(a).

5. This Court has personal jurisdiction over Defendant because it resides in this District. Consequently, Defendant is a resident and citizen of the State of Texas and this District.

6. Venue is proper in this district under 28 U.S.C. §1391(b)(2) because: 1) a substantial part of the events giving rise to Plaintiff's claims occurred within this District; 2) Defendant's acts of infringement giving rise to Plaintiff's claims occurred within this judicial District; and 3) Defendant resides in this District.

FACTUAL BACKGROUND

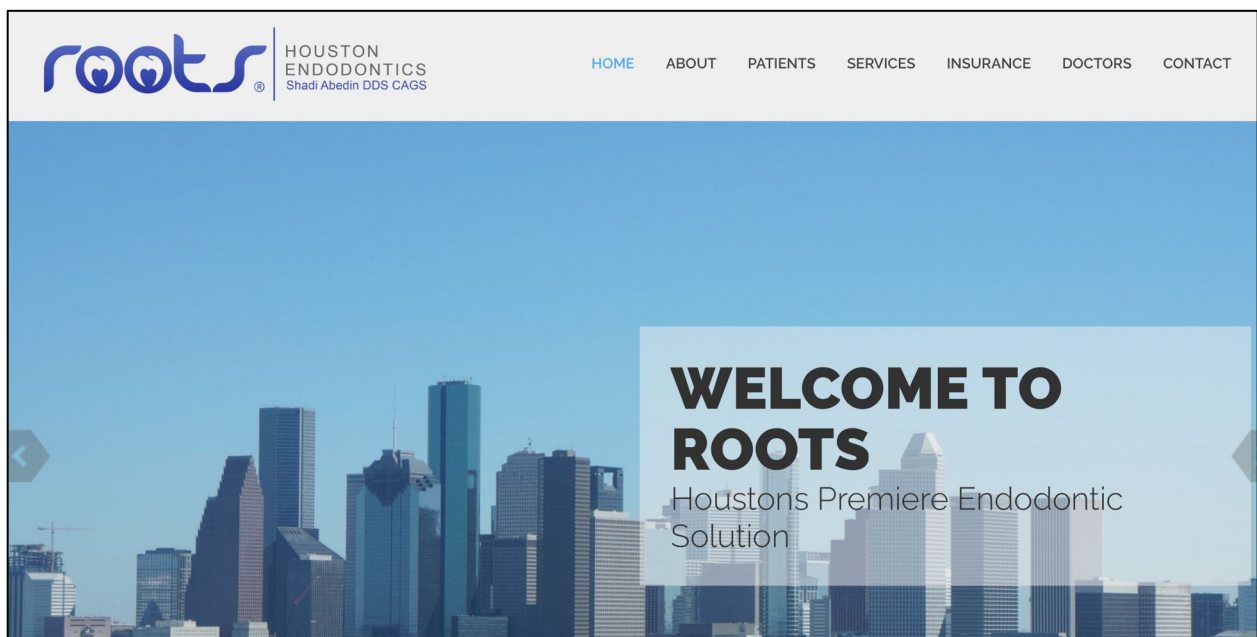
Plaintiff's Rights in the ROOTS Trademark

7. Plaintiff owns a federal registration for the standard character mark "ROOTS," filed on June 30, 2014 and registered on May 12, 2015, as U.S. Reg. No. 4,736,742 in International Class 44 for dental services, a true and correct copy of which is attached hereto as Exhibit A (hereinafter "Subject Registration").

8. Plaintiff, including the Subject Registration's predecessor in interest, has been continuously using the ROOTS mark of the Subject Registration in commerce since as early as July 10, 2014 in connection with dental services.

9. Plaintiff licenses the use of the ROOTS trademark in connection with dental services via a valid trademark licensing agreement, wherein any and all use and use in commerce of the ROOTS trademark by an authorized licensee of Plaintiff in connection with dental services inures to the benefit of Plaintiff.

10. One such authorized use in commerce of the ROOTS trademark in connection with dental services is shown below:¹



11. Through extensive and continuous use by Plaintiff of the ROOTS trademark, the mark has become well-known and recognized by the public.

12. Through such extensive and continued use in commerce of the ROOTS trademark for more than five years, Plaintiff's Subject Registration has obtained incontestable status under 15 U.S.C. §1065.

¹ Retrieved on 2022-08-23 from: <https://www.rootscanal.com> (cropped)

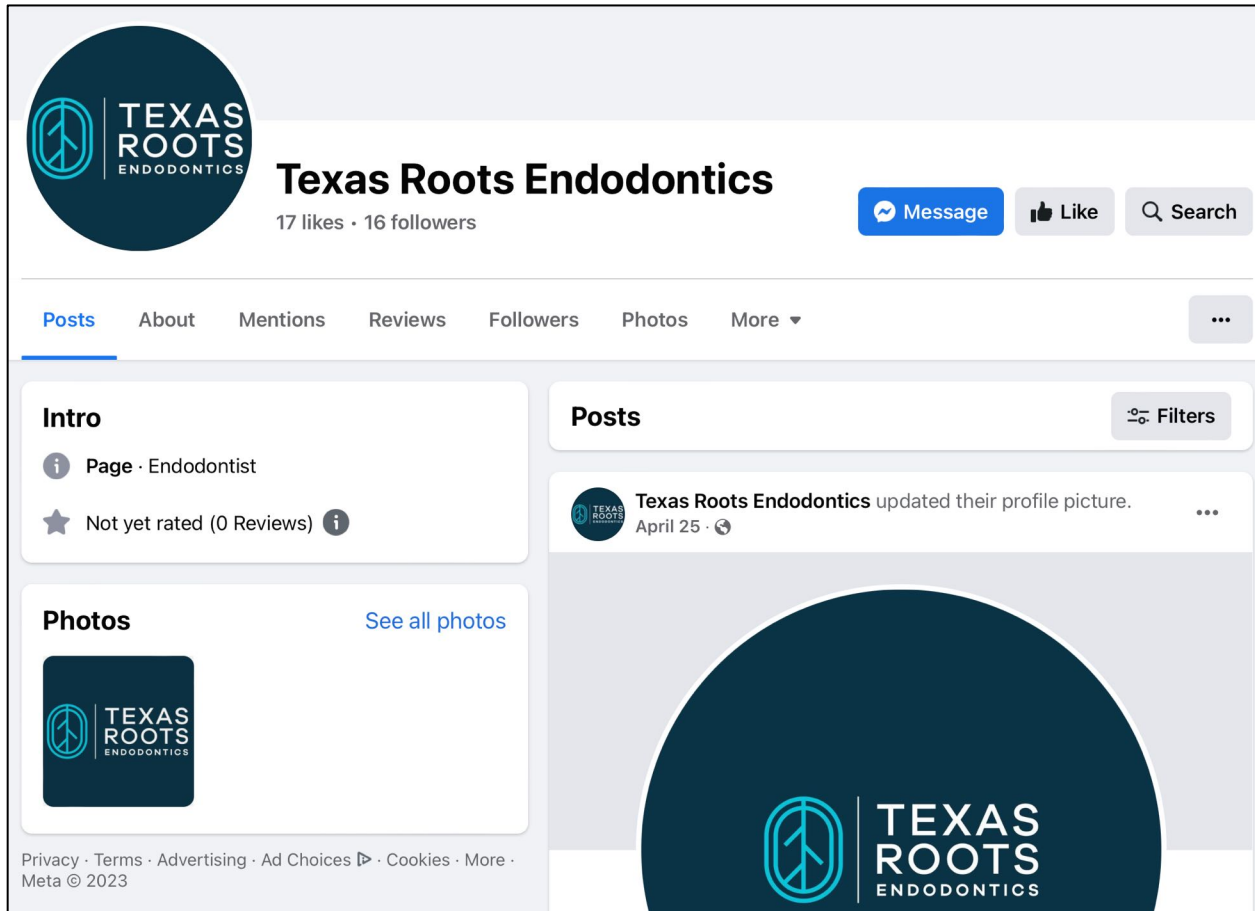
Defendant's Willful Trademark Infringement

13. Defendant Texas Roots Endodontics, PLLC is an endodontics practice providing dental services, such as root canal procedures, and operating under the marks "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS," as shown below from Defendant's website:²



² Retrieved on 2023-06-02 from: <https://www.texasrootsendodontics.com>

14. Defendant is also using the “TEXAS ROOTS” and “TEXAS ROOTS ENDODONTICS” marks on its Facebook page, as shown below:³



15. On information and belief, Defendant is also using or has been using the “TEXAS ROOTS” and “TEXAS ROOTS ENDODONTICS” marks on signage at its physical location, as shown below:⁴

³ Retrieved on 2022-08-23 from: <https://www.dotdental.com> (cropped)

⁴ Retrieved on 2022-08-23 from: https://www.google.com/maps/place/DOT+Dental/@29.7947467,-95.5424523,3a,75y,90t/data=!3m8!1e2!3m6!1sAF1QipNfpb_iRlua5llr53HcAMDvoAoL3BELZHmMHgkp!2e10!3e12!6shttps:%2F%2Flh5.googleusercontent.com%2Fp%2FAF1QipNfpb_iRlua5llr53HcAMDvoAoL3BELZHmMHgkp%3Dw203-h127-k-no!7i2016!8i1271!4m5!3m4!1s0x8640c5daa5cfeeb3:0x593c4c93aac0af72!8m2!3d29.7949817!4d-95.5424521



16. On March 15, 2023, Plaintiff sent a letter to Defendant and placed it on notice with respect to Plaintiff's rights in the ROOTS trademark and in the Subject Registration.

17. In its March 15, 2023 letter, Plaintiff demanded Defendant to immediately cease and desist all use of the confusingly similar "TEXAS ROOTS ENDODONTICS" mark in connection with its dental services.

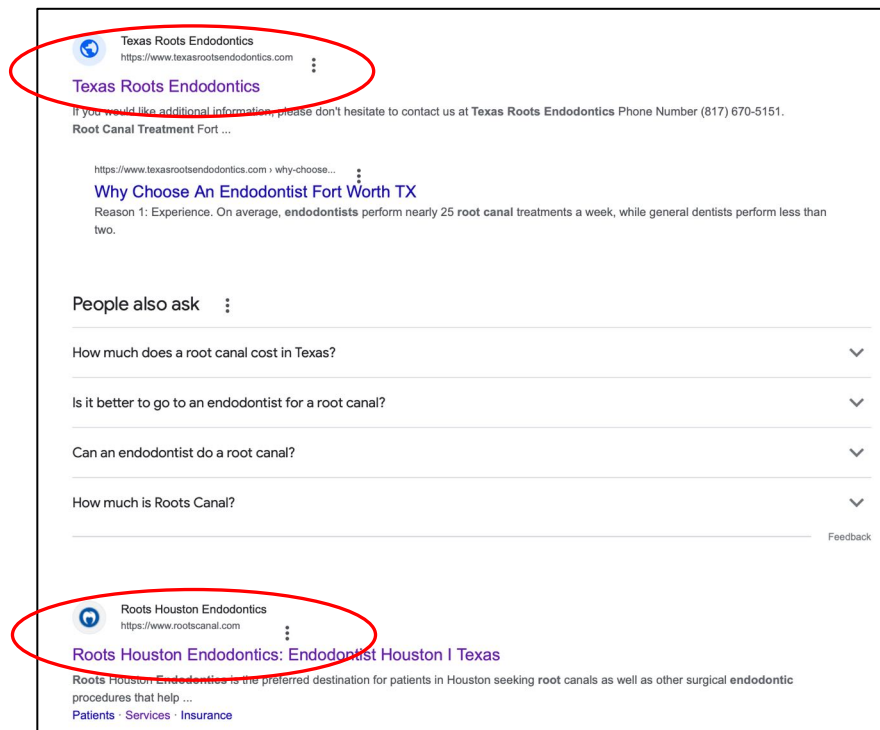
18. Despite acknowledging receipt of Plaintiff's March 15, 2023 letter and demands, Defendant did not cease and desist use of the "TEXAS ROOTS ENDODONTICS" mark and to this present day continues to use the "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS" marks in connection with dental services.

19. Plaintiff has not given Defendant permission, authorization, nor a license to use the ROOTS trademark or any variation of the ROOTS trademark of the Subject Registration for any purpose, and particularly not for use in connection with dental services.

20. Defendant's continuous use of the "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS" marks infringes upon Plaintiff's rights in the ROOTS trademark and in the Subject Registration.

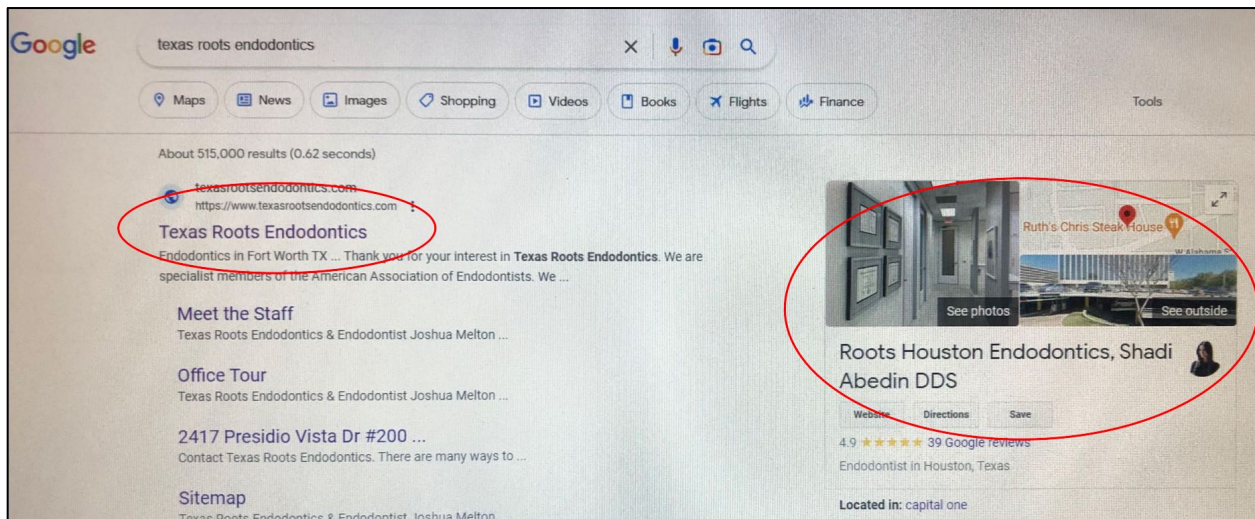
21. As a result of Defendant's infringing use of the confusing similar "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS" mark, third parties or customers have been and will likely be confused as to the source of the services associated with the mark.

22. In fact, an internet search performed in this District on the terms "roots endodontics texas" (without quotes) reveals Defendant's website directly above Plaintiff's use of the ROOTS mark, as shown below (annotated):⁵



⁵ Retrieved on 2023-06-02 from: <http://www.google.com>

23. Another internet search performed in Houston, Texas on the terms “texas roots endodontics” (without quotes) reveals Defendant’s website juxtaposed next to Plaintiff’s use of the ROOTS mark, as shown below (annotated):⁶



24. Defendant’s confusingly similar use of Plaintiff’s ROOTS trademark, and variations thereof, is intended to divert to the Defendant potential customers or interested third parties away from Plaintiff. Consequently, Defendant is misappropriating Plaintiff’s goodwill in the ROOTS trademark.

25. Defendant’s unauthorized use has caused and likely will continue to cause confusion with regards to whether Plaintiff is the source of, has endorsed or approved of, or is somehow legitimately associated with Defendant, thereby further injuring the goodwill Plaintiff has built in its ROOTS trademark of the Subject Registration. These actions are causing direct damage and irreparable injury to Plaintiff.

⁶ Retrieved on 2023-04-03 from: <http://www.google.com>

COUNT 1
FEDERAL TRADEMARK INFRINGEMENT

26. Plaintiff incorporates by reference paragraphs 1-25 above as if restated herein in their entirety.

27. Defendant has infringed and continues to infringe upon Plaintiff's federally registered and incontestable trademark for ROOTS by using the marks "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS" in connection with dental services.

28. Defendant's use of the marks "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS" in connection with dental services is likely to cause confusion among consumers as to the source of the services in view of Plaintiff's trademark rights in ROOTS and in the Subject Registration.

29. As a result of its unauthorized use of the ROOTS trademark in connection with dental services, Defendant is likely to cause confusion, to cause mistake or to deceive the public in violation of the Lanham Act, 15 U.S.C. § 1114.

30. On information and belief, Defendant's acts were and are undertaken willfully and in bad faith and in conscious disregard of Plaintiff's prior trademark rights in ROOTS, in a deliberate attempt to capitalize on the goodwill of Plaintiff and its registered trademark in ROOTS. Defendant thereby intended and intends to mislead the public into believing that there is a connection, affiliation, or association between Plaintiff and Defendant.

31. Defendant is trading on the goodwill symbolized by Plaintiff's registered trademark and, by reason of Defendant's acts, Plaintiff, including at least one authorized licensee of the ROOTS mark, has suffered and will continue to suffer damage and injury to its business and will sustain loss of revenues and profits.

32. Unless and until enjoined, Defendant's acts will immediately and irreparably injure Plaintiff's goodwill and cause confusion in the marketplace with regard to the source of the services for the ROOTS trademark.

COUNT II
FEDERAL UNFAIR COMPETITION

33. Plaintiff incorporates by reference paragraphs 1-32 above as if restated herein in their entirety.

34. Defendant has used the marks "TEXAS ROOTS" and "TEXAS ROOTS ENDODONTICS" in commerce and is currently displaying the marks prominently on the internet, among other places, in connection with dental services.

35. Defendant continues to explicitly use a confusingly similar form of the ROOTS trademark in commerce without authorization.

36. Defendant's unlawful acts are likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association of Defendant with Plaintiff.

37. Defendant's acts are causing irreparable injury to Plaintiff, for which there is no adequate remedy at law, and will continue to do so unless and until Defendant's use of the ROOTS trademark, and variations thereof, is enjoined by this Court.

38. Upon information and belief, Defendant's conduct as described above has been willful, wanton, reckless, and in total disregard for Plaintiff's rights.

39. Defendant has engaged in unlawful acts that constitute unfair competition and false designation of origin in violation of § 43(a) of the Lanham Act, codified at 15 U.S.C. § 1125(a), and Plaintiff is entitled to Defendant's profits resulting from those actions, the damages caused to Plaintiff as a result of those actions, the cost of this action, and reasonable attorneys' fees in accordance with 15 U.S.C. § 1117.

40. Unless temporarily and permanently restrained by this Court, Defendant's acts will immediately and irreparably injure Plaintiff and cause confusion in the marketplace with regard to the source of the services for the ROOTS trademark.

COUNT III
COMMON LAW TRADEMARK INFRINGEMENT

41. Plaintiff incorporates by reference paragraphs 1-40 above as if restated herein in their entirety.

42. The acts of Defendant complained of herein constitute trademark infringement in violation of the common law of the State of Texas.

COUNT IV
COMMON LAW UNFAIR COMPETITION

43. Plaintiff incorporates by reference paragraphs 1-42 above as if restated herein in their entirety.

44. The acts of Defendant complained of herein constitute unfair competition in violation of the common law of the State of Texas.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Roots IP, LLC respectfully requests that the Court enter judgment in its favor and against Defendant Texas Roots Endodontics, PLLC on Counts I-IV and award the following relief:

1. A preliminary and permanent injunction restraining, enjoining, and ordering Defendant, and its officers, agents, servants, attorneys, and any other entity or person actively working in concert or participation with it:

- a. To cease using the mark “TEXAS ROOTS”, “TEXAS ROOTS ENDODONTICS”, or any other colorable imitation or mark confusingly similar to the ROOTS trademark;
 - b. To cease advertising or promoting its service in a false or misleading manner; and
 - c. To destroy any and all advertising, marketing, or other informational materials in the possession, custody or control of Defendant bearing the “TEXAS ROOTS” or “TEXAS ROOTS ENDODONTICS” mark or any other colorable imitation or mark confusingly similar to the ROOTS trademark;
2. A finding that Defendant has committed trademark infringement under 15 U.S.C. § 1114;
 3. A finding that Defendant has committed unfair competition under 15 U.S.C. § 1125(a);
 4. Damages in an amount to be proven at trial;
 5. Disgorgement of Defendant’s profits;
 6. Enhanced damages under 15 U.S.C. § 1117 for Defendant’s willful and deliberate infringement of Plaintiff’s trademark;
 7. Attorney’s fees as a result of the exceptional nature of this case;
 8. Pre-judgment and post-judgment interest, including costs incurred in this case; and
 9. Any and all other relief as this Court may deem just and proper.

JURY DEMAND

Plaintiff Roots IP, LLC demands a trial by jury as to all issues so triable.

Respectfully Submitted,

Dated: June 6, 2023

/s/ Sam Sokhansanj

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